Office - Supreme Court, U.S.
FILED
OCT 24 1956
JOHN T. FEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 444

TATKO BROTHERS SLATE CO., INC.,
Petitioner,

v.

VERMONT STRUCTURAL SLATE CO., INC.,
Respondent.

RESPONDENT'S MEMORANDUM IN OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

RICHARD P. SCHULER
425 13th Street, N. W.
Washington, D. C.
Attorney for Respondent

Of Counsel:

BLAIR AND SPENCER
JOHN C. BLAIR
Stamford, Conn.

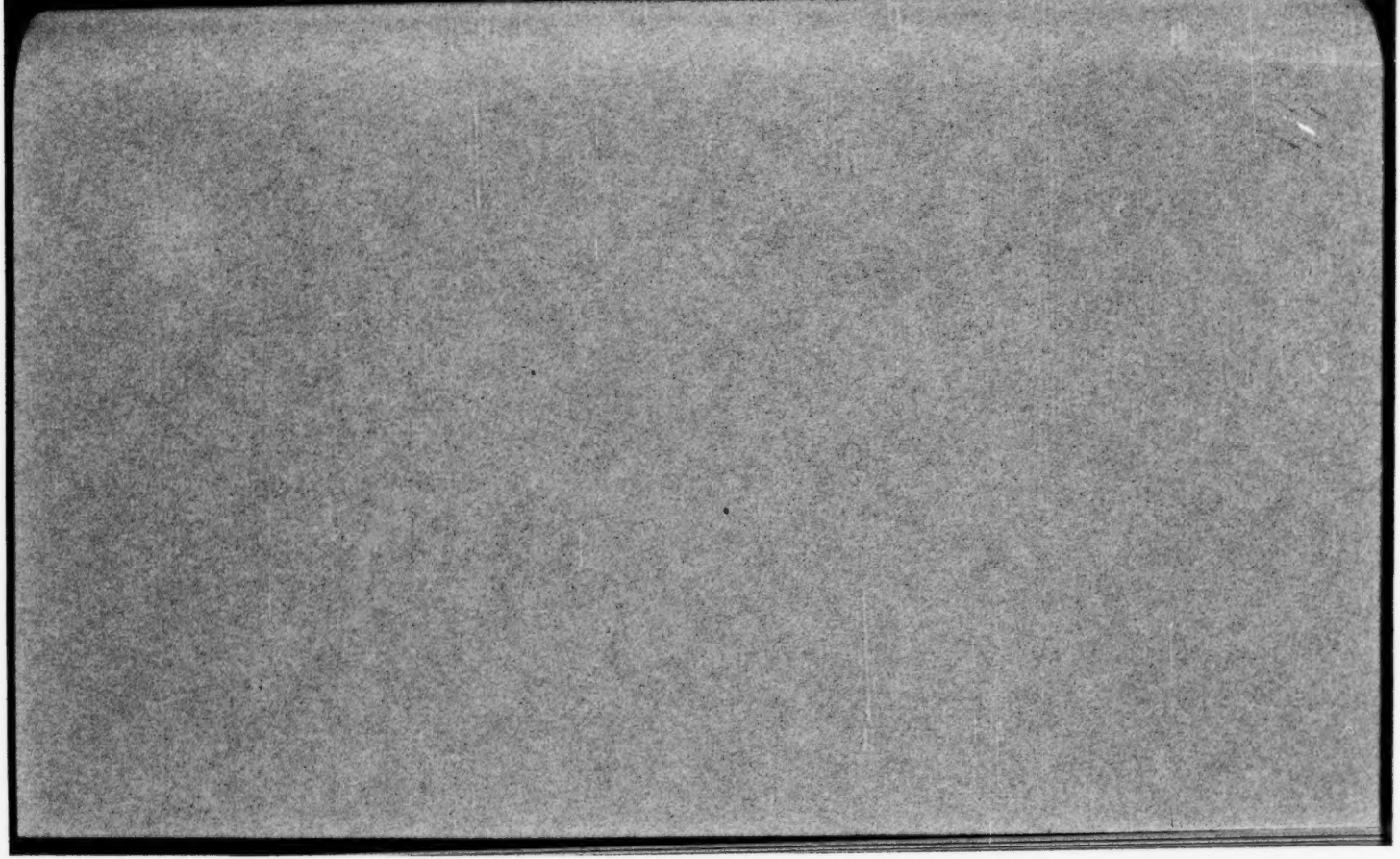


TABLE OF CONTENTS

STATEMENT OF THE CASE 2

ARGUMENT 3

There Is Nothing in the Opinion of the Court of Appeals Below Requiring Review by the Supreme Court 3

Petitioner's Conclusion That Section 103 of the United States Code and Case Interpretations Thereof Have Created Confusion As to Standards of Patentability Is Unsound 5

The Court of Appeals Did Not Err in Holding the Tatko Patent Invalid Without Trial 7

CONCLUSION 9

CITATIONS

Atlantic Works *v.* Brady, 107 U. S. 192 (1882) 3

Black Diamond Co. *v.* Excelsior Co., 156 U. S. 611 (1895) 4

Brown *v.* Piper, 91 U. S. 37 (1875) 4

Concrete Appliances Co. *v.* Gomery, 269 U. S. 177 (1925) 3, 4

Duer *v.* Corbin Cabinet Lock Co., 149 U. S. 216 (1892) 3

Dunbar *v.* Meyers, 94 U. S. 187 (1876) 5, 7

General Motors Corp. *v.* Estate Stove Co., 203 F. 2d 912 (C. A. 6, 1953) 6

PAGE

Great Atlantic & Pacific Tea Co. *v.* Supermarket Equipment Corp., 340 U. S. 147 (1950) ---------- 8

Hendy *v.* Miners' Iron Works, 127 U. S. 370 (1888) 3

Hollister *v.* Benedict Manufacturing Co., 113 U. S. 59 (1885) ---------- 3

Hotchkiss *v.* Greenwood, 11 How. 248 (52 U. S.) (1850) ---------- 5

Interstate Rubber Prod. Corp. *v.* Radiator Specialty Co., 214 F. 2d 546 (C. A. 4, 1954) ---------- 6

Lyon *v.* Bausch & Lomb Optical Co., 224 F. 2d 530 (C. A. 2, 1955) ---------- 6

Mahn *v.* Harwood, 112 U. S. 354 (1884) ---------- 8

Market Street Railway Co. *v.* Rowley, 155 U. S. 621 (1895) ---------- 3

Application of O'Keefe, 202 F. 2d 767 (C. C. P. A. 1953) ---------- 6

Olin *v.* Timken, 155 U. S. 141 (1894) ---------- 3

Pacific Contact Laboratories *v.* Solex Laboratories, 209 F. 2d 529 (C. A. 9, 1953) ---------- 6

Packwood *v.* Briggs & Stratton Corp., 195 F. 2d 971 (C. A. 3, 1952) ---------- 8

Phillips et al. *v.* Detroit, 111 U. S. 604 (1884) ---- 3

Pomace Holder Company *v.* Ferguson, 119 U. S. 335 (1886) ---------- 3

Richards *v.* Chase Elevator Co., 158 U. S. 299 (1895) ---------- 4

Slawson *v.* Grand Street R. R. Co., 107 U. S. 649 (1882) ---------- 3, 4

Specialty Mfg. Co. *v.* Fenton Mfg. Co., 174 U. S. 492 (1899) ---------- 4

PAGE

Stanley Works *v.* Rockwell Mfg. Co., 203 F. 2d 846 (C. A. 3, 1953) ---------- 6

Tatko Brothers Slate Co., Inc. *v.* Matthew Hannon, ------ F. Supp. ------ (D. C.Vt., 1956) ------- 7

Vincent *v.* Suni-Citrus Products Co., 215 F. 2d 305 (C. A. 5, 1954) ---------- 6

Wasserman *v.* Burgess & Blacher Co., 217 F. 2d 402 (C. A. 1, 1954) ---------- 6

Watson *v.* Heil, 192 F. 2d 982 (C. A. 4, 1951) ------ 8

Werk *v.* Parker, 249 U. S. 130 (1919) ---------- 3

Statutes

35 U. S. C. § 103 ----------1, 3, 5, 6

Rules

Rule 19 of the Rules of the Supreme Court of the United States ---------- 6

IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 444

TATKO BROTHERS SLATE CO., INC.,
Petitioner,

v.

VERMONT STRUCTURAL SLATE CO., INC.,
Respondent.

RESPONDENT'S MEMORANDUM IN OPPOSITION TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Respondent, Vermont Structural Slate Co., Inc., opposes the petition for a writ of certiorari on the following grounds:—

1. There is nothing in the opinion of the Court of Appeals below requiring or justifying a review of this case by the Supreme Court.

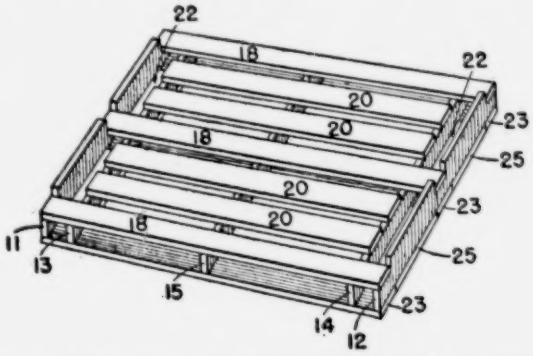
2. Petitioner's conclusion that Section 103* and case interpretations thereof have created confusion as to standards of patentability is unsound.

3. The Court of Appeals did not err in holding the Tatko patent invalid without trial.

* 35 U. S. C. § 103.

STATEMENT OF THE CASE

The petition, like the drawings and specification of the Tatko patent in suit (R. 35a-37a), fosters an atmosphere of complexity when, in fact, the construction involved is the utmost in simplicity. The patent discloses a pallet for use with a fork lift truck such as have been in extensive use long prior to the alleged invention. A glance at a clear showing of the Tatko pallet and a few words of explanation are all that is necessary to a complete understanding thereof.



Boards 23 form the bottom and boards 18 and 20 its top. Stringers 11, 12, 13, 14 and 15 are interposed therebetween. Boards 20 are shorter than boards 18 to form pockets 22 for insertion of stone end pieces which hold stacked flagstones thereon. Fork lift trucks may thus lift and transport these loaded pallets.

The three Tatko claims despite their "magical setting of words"* define no more than the structure disclosed, to wit, a pair of spaced horizontal platforms with traversing stringers therebetween, some of the top boards being shorter to provide pockets in the ends of the pallets for insertion of stone end pieces.

---

* District Court, opinion below. (R. 92a).

In the final analysis, the Tatko innovation amounts to the suggestion that slots be provided at the ends of a well-known standard pallet (R. 38a) for the reception of stone end pieces which act in a known manner to hold the remaining stones on the pallet (R. 45a).

Petitioner's erroneous interpretations of the holdings below and its asserted "conflict" in the Second Circuit are discussed hereinafter (*infra* P. 7).

ARGUMENT

THERE IS NOTHING IN THE OPINION OF THE COURT OF APPEALS BELOW REQUIRING REVIEW BY THE SUPREME COURT

Petitioner contends that the District Court "did not understand the nature of 'invention' as a requirement for patentability" and that the Court of Appeals erred in "perpetuating the same error of law" (Petition, P. 6). The fact is that the Court of Appeals, when ruling on validity followed precisely the standards of patentability recognized and followed by this Court for more than a century.* These long recognized standards were finally codified in Section 103 of the Patent Act

---

* *Atlantic Works* v. *Brady*, 107 U. S. 192 (1882); *Slawson* v. *Grand Street R. R. Co.*, 107 U. S. 649 (1882); *Phillips et al.* v. *Detroit*, 111 U. S. 604 (1884); *Pomace Holder Company* v. *Ferguson*, 119 U. S. 335 (1886); *Hendy* v. *Miners' Iron Works*, 127 U. S. 370 (1888); *Hollister* v. *Benedict Manufacturing Co.*, 113 U. S. 59 (1885); *Duer* v. *Corbin Cabinet Lock Co.*, 149 U. S. 216 (1893); *Olin* v. *Timken*, 155 U. S. 141 (1894); *Market Street Railway Co.* v. *Rowley*, 155 U. S. 621 (1895); *Werk* v. *Parker*, 249 U. S. 130 (1919); *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177 (1925).

of 1952 (Title 35 United States Code). The Court of Appeals below stated:

> "The prior art and the patent claims are, without expert aid, easily understandable by anyone of the most modest intelligence. Nor did it require expert testimony to make it plain that the differences between the prior art and the patent claims were obvious to persons having ordinary skill in the trade at the time the alleged invention was made."*

It has long been established law that Courts may take judicial notice of obvious facts in the prior art, and, where as here, the claimed invention is easy to comprehend a court may apply accepted legal standards of patentability thereto**; such circumstance obviates the necessity for a trial. To hold otherwise would make a mockery of summary judgment proceedings in patent cases; to defeat such a motion the patent proponent would merely be required to file affidavits claiming utility for the invention. Such a result was never intended in a case such as this. As well stated by the Court of Appeals:

> "Summary judgment represents a most useful legal invention to save time and expense, by the avoidance of a trial, when there exist no material fact-issues. It may well be that, in a patent case, a judge should exercise unusual caution in granting a summary judgment. But there are patent cases where it would be an *absurd waste of time* and effort to deny such a judgment. *This is such a case.*"***

---

* Petition's Appendix, P. 2a.

** *Brown v. Piper,* 91 U. S. 37 (1875); *Slawson* v. *Grand Street R. R. Co.,* 107 U. S. 649 (1882); *Black Diamond Co.* v. *Excelsior Co.,* 156 U. S. 611 (1895); *Richards* v. *Chase Elevator Co.,* 158 U. S. 299 (1895); *Specialty Mfg. Co.* v. *Fenton Mfg. Co.,* 174 U. S. 492 (1899); *Concrete Appliances Co.* v. *Gomery,* 269 U. S. 177 (1925).

*** Petition's Appendix P. 2a—emphasis added.

Having found no genuine issue as to any material fact, the Court of Appeals was free to hold as a matter of law:

> "The patent disclosed no more ingenuity than that of a man skilled in the art."*

PETITIONER'S CONCLUSION THAT SECTION 103 OF THE UNITED STATES CODE AND CASE INTERPRETATIONS THEREOF HAVE CREATED CONFUSION AS TO STANDARDS OF PATENTABILITY IS UNSOUND

Petitioner's asserted "conflict", "doubt" and "confusion"** over interpretation of Section 103 relating to standards of patentability is imaginary and at best wishful thinking. Indeed, this law has remained unchanged since *Hotchkiss* v. *Greenwood,* 11 How. (52 U. S.) 248 (1850), enunciated the principle. As stated by this Court in *Dunbar* v. *Meyers,* 94 U. S. 187,197 (1876),

> "Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent; and it was decided by this court, more than a quarter of a century ago, that unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention."

Section 103 is a plain and accurate codification of this law. It says that a "patent may not be obtained" on anything which differs from the prior art in a man-

---

* Petition's Appendix P. 3a.

** Petition P. 7.

ner which "would have been obvious . . . to a person having ordinary skill in the art to which the subject matter pertains." Since the enactment of Section 103, Courts have consistently held that it made no change in this settled test of patentability.*

The petition attempts to capitalize on the footnote in Judge Frank's opinion wherein he expresses "serious doubts" about Judge Learned Hand's ruling in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (C. A. 2, 1955). Whether any significant divergence in viewpoint exists in the Court of Appeals is to be doubted. But assuming such to be the case it is immaterial here for it is not such a "special and important" reason** as would justify review by this Court.

At the very most, Judge Hand merely held that Section 103 restored the standards of patentability which existed roughly 25 years before the Patent Act of 1952.***

And that law referred to as established for 70 or 80 years is the very law relied upon by the Court of Appeals in invalidating the Tatko patent.† Indeed,

---

* *Wasserman* v. *Burgess & Blacher Co.*, 217 F. 2d 402 (C. A. 1, 1954); *Interstate Rubber Prod. Corp.* v. *Radiator Specialty Co.*, 214 F. 2d 546 (C. A. 4, 1954); *Vincent* v. *Suni-Citrus Products Co.*, 215 F. 2d 305 (C. A. 5, 1954); *Stanley Works* v. *Rockwell Mfg. Co.*, 203 F. 2d 846 (C. A. 3, 1953); *General Motors Corp.* v. *Estate Stove Co.*, 203 F. 2d 912 (C. A. 6, 1953); Application of *O'Keefe*, 202 F. 2d 767 C. C. P. A. (1953); *Pacific Contact Laboratories* v. *Solex Laboratories*, 209 F. 2d 529 (C. A. 9, 1953).

** Rule 19 of the Rules of the Supreme Court of the U. S.

*** "In the first place § 103 only restores the original gloss, substantially in ipsissimis verbis; which has never been overruled; but on the contrary for 70 or 80 years had continued to be regarded as authoritative." 224 F. 2d 530, 536.

† "Plaintiff argues that the recent amendment to the patent statute, 35 U. S. C. Section 103, lowered the standard of invention, citing *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 535-536 (C. A. 2). Even so, the plaintiff's patent, we think, is clearly sub-standard." Petition's Appendix P. 3a.

Section 103 does not depart one iota from that principle so well stated in 1876 by this Court in *Dunbar* v. *Meyers, supra.*

* * * * *

The supplemental petition asserts that the District Court's decision in *Tatko Brothers Slate Co., Inc.* v. *Matthew Hannon** is "directly in conflict" with the decision of the Court of Appeals here sought to be reviewed.

Petitioner's present assertions are in direct conflict with counsel's argument before Judge Gibson which was successful in persuading the Court that there was an issue before it *which had not been before the Court of Appeals.* A reading of Judge Gibson's opinion leaves no doubt that this was his understanding,

> " The affidavits in *this* case disclose the utility, safety, economy, and commercial success of the Tatko pallet. Similar affidavits were filed in the former case. In *this* case, *however,* the affidavits *also* tend to show that the industry had tried to solve the problem of handling and transporting flagstone over a long period of time, all without success."**

Thus, Judge Gibson held "that a genuine issue of a material fact is present in *this case.*" (Tatko Brothers v. Hannon in Vermont). Therefore, for that reason alone, the Vermont Court denied the defendant's motion for summary judgment.

---

* ....F. Sup. ....., (D. C. Vt. 1956), Supplement to Petition's Appendix, P. 1a.

** Supplement to Petition's Appendix P. 3a, emphasis added.

THE COURT OF APPEALS DID NOT ERR IN HOLDING THE TATKO PATENT INVALID WITHOUT TRIAL

The petition confuses the issue by using the term "invention" to designate two things, to wit, (1) the subject matter sought to be patented (here the construction of the Tatko pallet) and (2) the question of patentability (here whether such pallet is patentable).* By so doing it concludes erroneously that patentability cannot be determined "as a matter of law by judicial comparison of the thing invented with the things of the prior art" but only "as a matter of fact by weighing the available evidence." This is precisely contrary to established law. The question whether certain subject matter is patentable has always been one of law.**

A condition precedent to such determination is an understanding of the subject matter sought to be patented. Here, the Court of Appeals first found that " The prior art and the patent claims are, without expert aid, easily understandable by anyone of the most modest intelligence." It then ruled as a matter of law that the patent is invalid.

In *Packwood* v. *Briggs & Stratton Corp.*, 195 F. 2d 971 (C.A. 3, 1952) cited in the petition*** the Court correctly held that once the subject matter had been established by evidence, patentability had to be measured as a matter of law against established legal standards. *Watson* v. *Heil,* 192 F. 2d 982 (C.A. 4,

---

* Petition, Pp. 6-7, 10.

** *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 155; *Mahn* v. *Harwood,* 112 U. S. 354, 358 (1884).

*** Petition, P. 10.

1951), is not in conflict with this ruling, for it merely held that evidence of the state of the art might tip the scales in favor of patentability and hence such evidence should have been considered by the trial court. In the present case the Court of Appeals held that because the question *was not at all close* such evidence could not possibly affect the ultimate result.†

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

RICHARD P. SCHULZE
Attorney for Respondent

Of Counsel:

BLAIR AND SPENCER
JOHN C. BLAIR
Stamford, Conn.

October 22, 1956

† Petition's Appendix P. 3A.